

ESTTA Tracking number: **ESTTA693581**

Filing date: **09/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223243
Party	Defendant Bella Collina Events LLC
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Submission	Motion to Suspend for Civil Action
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Date	09/03/2015
Attachments	Motion_to_Suspend_Proceedings.pdf(301828 bytes) Exhibit A to Motion to Suspend.PDF(893945 bytes) Exhibit B to Motion to Suspend.PDF(68584 bytes) Exhibit C to Motion to Suspend.PDF(211703 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DCS INVESTMENT HOLDINGS, LLC,)	Opposition No. 91223243
)	Serial No. 86362378
<i>Opposer,</i>)	
)	
v.)	
)	
BELLA COLLINA EVENTS LLC,)	<u>MOTION TO SUSPEND</u>
)	<u>PROCEEDINGS PENDING</u>
)	<u>OUTCOME OF PENDING CIVIL</u>
<i>Applicant.</i>)	<u>ACTION</u>
)	

Applicant Bella Collina Events, LLC (“BCE”), through its undersigned counsel, hereby files this Motion to Suspend Proceedings Pending Outcome of Civil Action and requests suspension of the proceedings pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a), pending the outcome of a civil action involving BCE and an entity apparently related to Opposer DCS Investment Holdings, LLC (“DCS Investment”).

RELEVANT FACTS

The TTAB Proceedings

On August 11, 2015, DCS Investment filed its Notice of Opposition to BCE’s trademark application (Serial No. 86/362,378) for BELLA COLLINA EVENTS.

DCS Investment alleges in its Notice of Opposition that “[s]ince at least 2010 . . . Opposer has been, and still is, engaged in the provision of, *inter alia*, wedding planning services, providing facilities for wedding ceremonies, planning and arranging of wedding ceremonies, and other, similar activities, under the mark BELLA COLLINA and related marks.” Notice of Opp. ¶ 2.

As recited in its Notice of Opposition, DCS Investment has filed a trademark application (U.S. Serial No. 86431330) for the mark BELLA COLLINA for “[p]arty and wedding reception planning, coordination and consultation services . . .’ in International Class 041.” Notice of Opp.

¶ 4. DCS Investment also filed an application for a composite logo of BC BELLA COLLINA (U.S. Serial No. 86431338). Notice of Opp. ¶ 4. Both of DCS Investment's applications have been suspended due to BCE's application.

DCS Investment also alleges that it "owns other BELLA COLLINA marks in other international classes, including U.S. Registration Number 2,936,715, for 'real estate development and construction services, namely, planning and developing an upscale residential community and resort' in International Class 037." Notice of Opp. ¶ 4.

DCS Investment further alleges that it has built up valuable goodwill in the BELLA COLLINA marks with which it sells its goods and services and that it has "extensive common law rights" in the BELLA COLLINA marks, including use of the marks "in connection with wedding events, services, and planning." Notice of Opp. ¶¶ 7-8.

Among the grounds for its opposition, DCS Investment cites its prior rights in the BELLA COLLINA marks and the likelihood of confusion. Notice of Opp. ¶¶ 12-17.

The Civil Action

Long before this this Opposition was filed, on December 11, 2014, a different but obviously related DCS entity—DCS Real Estate Investments, LLC ("DCS Real Estate")—filed a lawsuit against BCE in the United States District Court for the Middle District of Florida. A true and correct copy of the Florida federal complaint is attached hereto as **Exhibit A**. In that lawsuit, DCS Real Estate alleged that "[o]ne of the assets acquired by DCS was the service mark BELLA COLLINA," that "BELLA COLLINA is a registered service mark," and "[i]ts Registration Number is 2936715." Ex. A, M.D.Fla. Complaint ¶¶ 8 & 9. That is the exact same registration cited in the Notice of Opposition. Upon BCE's motion, the Florida federal court lawsuit was dismissed on February 12, 2015 due to lack of personal jurisdiction over BCE.

Meanwhile, on January 7, 2015 BCE brought a declaratory judgment action against the DCS entity which had sued it in federal court in Florida, the same DCS entity which is the last listed owner (on USPTO records) of Registration 2936715, namely, DCS Real Estate. BCE filed in the United States District Court for the Middle District of North Carolina. The case is styled *Bella Collina Events, LLC v. DCS Real Estate Investments, LLC*, 1:15-cv-00007 (the “Civil Action”). A true and correct copy of the North Carolina federal complaint is attached hereto as **Exhibit B**. BCE seeks, *inter alia*, a declaratory judgment that it has not infringed on the BELLA COLLINA mark bearing Registration Number 2,936,715 for real estate development and construction services. Ex. B, Compl. ¶ 1.

On April 17, 2015 (just four months before the Notice of Opposition was filed), DCS Real Estate answered BCE’s Complaint and asserted Counterclaims against BCE. A true and correct copy of the Answer and Counterclaims is attached hereto as **Exhibit C**. DCS Real Estate admitted that it acquired the BELLA COLLINA mark bearing Registration Number 2,936,715 for real estate development and construction services through assignment. Ex. C, Answer ¶ 16, p. 6. In its Counterclaim allegations, DCS Real Estate further alleges it “owns the common law trademark rights to BELLA COLLINA for a variety of goods and services, including, *inter alia*, weddings, wedding planning, and other events.” Ex. C, Counterclaim ¶ 9.

In the Civil Action, DCS Real Estate has filed counterclaims for trademark infringement against BCE and “seeks a declaration from the Court that it enjoys the exclusive right to use the service mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services, and that BCE . . . lacks the right to use the mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services.” Ex. C, Counterclaim ¶ 49. DCS Real Estate further

alleges that “BCE has wrongfully attempted to register the BELLA COLLINA mark even though it knows that DCS was using the mark more than three years prior to plaintiff’s first use of said mark.” Ex. C, Counterclaim ¶ 50.

Both DCS entities have been, and are, represented by the same counsel in each of the three cases—the Florida federal court case, the North Carolina federal court case, and this Opposition. Their law firm has been the Orlando, Florida law firm of Shutts & Bowen LLP.

The Civil Action remains pending in the United States District Court for the Middle District of North Carolina. Discovery is advanced and ongoing in the Civil Action. Each side has served and provided responses to written discovery. The time period for fact discovery in the Civil Action is currently set to end on November 4, 2015. The Civil Action has been set for trial on October 3, 2016.

ARGUMENT

BCE respectfully requests the Board suspend the above-captioned proceeding (the “Opposition”) until such time that the Civil Action pending in the United States District Court for the Middle District of North Carolina is terminated. Trademark Rule 2.117(a) provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or other Board Proceeding.

37 C.F.R. § 2.117(a); *see also* T.B.M.P § 510.02. The test for suspension is whether the civil action has a bearing upon the Board proceeding. The civil action may, in some cases, be dispositive, although the civil action’s decisions need not be dispositive for this Board to suspend proceedings. *See, e.g., New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

Here, several issues that will be determined in the Civil Action will, at least, have a bearing on this Board proceeding. In this Opposition, DCS Investment pleads as the basis for its opposition to BCE's Application that (1) it owns the BELLA COLLINA mark bearing Registration Number 2,936,715 for real estate development and construction services; (2) it has applied for and began using prior to BCE's Application, the BELLA COLLINA and BC BELLA COLLINA marks for party and wedding reception planning, coordination and consultation services bearing U.S. Serial Numbers 86431330 and 86431338, respectively; and (3) it has extensive common law rights in the BELLA COLLINA marks for those goods and services listed in BCE's Application.

In the pending Civil Action, a different, but obviously related DCS entity—DCS Real Estate—pleads as the basis for its defense and counterclaims that (1) it owns the BELLA COLLINA mark bearing Registration Number 2,936,715 for real estate development and construction services; and (2) it owns the common law rights in the BELLA COLLINA marks for those goods and services listed in BCE's Application (wedding-related services).

The ownership and rights in the BELLA COLLINA mark bearing Registration Number 2,936,715 and the common law rights in BELLA COLLINA for wedding-related services are thus at issue in both this Opposition and the Civil Action.

Priority and likelihood of confusion surrounding the use of BELLA COLLINA in connection with wedding-related services are also issues in both proceedings. *See* Notice of Opp. ¶¶ 12-17 (setting forth Count I, entitled "Likelihood of Confusion"); Ex. B, Complaint ¶¶ 34 (seeking a declaration that in BCE's geographic territory, BCE's trademark rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS Real Estate in BELLA COLLINA for wedding related services). Furthermore, in the Civil Action, DCS Real Estate seeks a declaration that it enjoys the *exclusive* right to use the service

mark BELLA COLLINA in connection with the marketing and sale of wedding-related services *and* that BCE lacks the right to use the BELLA COLLINA mark in connection with its own marketing and sale of wedding-related services. Ex. C, Counterclaim ¶ 49. The Civil Action even addresses the very trademark application at issue in this Opposition and whether BCE has properly attempted to register the mark despite the alleged prior use by the DCS entity. Ex. C, Counterclaim ¶ 50.

Although two different DCS entities are involved, it is clear from the similarities of each entity's allegations that the underlying ownership, rights, and alleged uses are identical (i.e. the rights in the registered BELLA COLLINA mark, common law rights, and the pending applications for the BELLA COLLINA and BC BELLA COLLINA marks). Therefore, any determination made by the United State District Court as to BCE's claim for declaratory judgment or DCS Real Estate's counterclaims for infringement and declaratory judgment will certainly have bearing on this proceeding as to BCE's right to use the BELLA COLLINA EVENTS mark in connection with wedding-related services and even BCE's trademark application itself. The District Court's decisions may even be dispositive of the issues of this case, depending upon the relationship of the DCS entities. The DCS entities may be alter egos of each other or have some other highly-related corporate relationship which they have not yet chosen to disclose to BCE or this Board.

In accordance with Trademark Rule 2.117(a) and the "policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case," this Opposition should be suspended until the Civil Action is disposed of." *See, e.g., Arcadia Grp. Brands Ltd. v. Studio Moderna SA*, 99 USPQ2d 1134, 1136 (TTAB 2011) (suspending proceeding and noting that a court's finding on trademark infringement may dispose of the likelihood of confusion claim before the Board).

Respectfully submitted this 3rd day of September, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion to Suspend Proceedings has been served on the following by mailing said copy on September 3, 2015, via First Class Mail, postage prepaid:

Daniel J. Barsky, Esq.
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West Palm Beach, FL 33401
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/s/ Kimberly M. Marston
Kimberly M. Marston

EXHIBIT A to Motion to Suspend

DCS Inv. Hldgs. LLC v. Bella Collina Events, LLC

Opposition No. 91223243

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
OCALA DIVISION

FILED

2014 DEC 11 PM 3:22

US DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO, FLORIDA

DCS REAL ESTATE INVESTMENTS, LLC,
a Florida Limited Liability Company,

Plaintiff,

v.

CASE NO. 5:14-cv-678-oc-30PRL

JURY TRIAL DEMANDED

BELLA COLLINA EVENTS, LLC, a
North Carolina limited liability company,

Defendant.

COMPLAINT

The plaintiff, DCS Real Estate Investments, LLC ("DCS"), sues the defendant, Bella Collina Events, LLC, and alleges as follows:

Jurisdiction, Parties & Venue

1. This Court has subject matter jurisdiction pursuant to 15 U.S.C. §§ 1125(a) (Lanham Act), 28 U.S.C. § 1331 (federal question) and 1338 (patent, trademark and copyright), and pursuant to 28 U.S.C. § 1367 (supplemental jurisdiction).

2. The plaintiff, DCS, is a Florida Limited Liability Company with its principal place of business in Lake County, Florida. It conducts business in Lake County, Florida.

3. Defendant Bella Collina Events, LLC ("BC") is a North Carolina limited liability company with its principal place of business in Guilford County, North Carolina.

4. Jurisdiction over the defendant exists because it solicits business in the State of Florida through, among other media, The Wedding Wire and www.theknot.com, and has caused economic harm to DCS in Florida. More specifically, the defendant is subject to personal jurisdiction in Florida under the Florida Long Arm Statute (Fla. Stat. § 48.193) as it has operated, conducted, engaged in, or carried out a business or business venture in the State of Florida. Additionally, the defendant has purposefully directed its activities at Florida, the asserted claim arises out of those activities, and the assertion of personal jurisdiction over the defendant is reasonable and fair. As set forth in more detail below, the defendant actively uses the internet to conduct business activities in the State of Florida, those business activities are the basis of the claims herein, and assertion of personal jurisdiction in this matter is reasonable and fair as the defendant's activities were purposefully directed at, *inter alia*, Florida.

5. Venue is proper in this district pursuant to 28 U.S.C. § 1400(a) and 28 U.S.C. § 1391(b), because the defendant has sought business in the State of Florida, including in the Middle District of Florida, and the harm caused has accrued in the Middle District of Florida.

6. DCS has retained the undersigned firm and has agreed to pay a reasonable attorney fee.

7. All conditions precedent to this action have occurred or have been waived. DCS demands a jury trial on all issues so triable.

General Allegations

8. In 2012, DCS acquired the club house, golf course, and other assets located at and part of the exclusive Lake County residential community known as "Bella Collina." One of the assets acquired by DCS was the service mark BELLA COLLINA (the "Mark").

9. BELLA COLLINA is a registered service mark on the United States Patent and Trademark Office's Principal Register. Its Registration Number is 2936715. The service mark is also incontestable. Additionally, DCS owns the common law trademark rights to BELLA COLLINA for a variety of goods and services, including, *inter alia*, weddings, wedding planning, and other events.

10. DCS uses BELLA COLLINA to market and promote the Bella Collina community and facilities, including weddings, wedding planning, and other events.

11. Since 2003, the owners of BELLA COLLINA have maintained continuous and uninterrupted use of the service mark through advertising, promotions and website. Since 2010, DCS has promoted its facilities as a destination wedding venue to consumers, and potential consumers, around the country and world.

12. The defendant owns a website found at URL <http://www.bellacollinamansion.com>. Through the website the defendant promotes wedding services, planning, and events. The defendant also advertises nationally, at wedding-oriented sites such as The Wedding Wire and www.theknot.com, its wedding services.

13. As a result of the defendant's advertisements and solicitations, including those directed at Florida, potential customers have actually confused the defendant's services with those offered by DCS.

14. Counsel for DCS contacted the defendant to inform the defendant that DCS owned and used BELLA COLLINA in the advertising, promotion, and sale of wedding services, including planning and events, at DCS' real property in Lake County, Florida.

15. Rather than acting to prevent confusion or changing the name under which it conducted business, the defendant responded by attempting to register with the United States Patent and Trademark Office the mark BELLA COLLINA EVENTS for wedding planning

and services under application serial number 86362378. Such attempt at registration is fraudulent and improper as the defendant was well aware that it is not the prior user of the BELLA COLLINA mark for wedding planning and events.

COUNT I: LANHAM ACT VIOLATION – SERVICE MARK INFRINGEMENT

16. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

17. In or about 2010, the owner of BELLA COLLINA began offering wedding facilities and services using the BELLA COLLINA Mark. This use included using the BELLA COLLINA Mark in advertisements and other media, including www.theknot.com.

18. DCS has expended considerable resources (including thousands of dollars) marketing, advertising, and promoting wedding services under the Mark throughout the United States and the State of Florida.

19. The BELLA COLLINA Mark is distinctive and well known to the general public. The public generally associates the Mark with DCS's events, including wedding planning and events. DCS's facilities have become famous nationally for high-end destination weddings.

20. The Mark has never been abandoned.

21. The Mark is distinctive and famous.

22. The defendant has been and currently is using the Mark to advertise, promote, and sell wedding planning and event services. The defendant has gone so far as to attempt to register a confusingly similar mark even though defendant admits that it first began using the confusingly similar and/or counterfeit mark in 2013, more than three years after DCS's first use of the Mark.

23. The defendant's unauthorized reproduction, copying, imitation, and use of the Mark constitutes service mark infringement and is likely to cause confusion and mistake in the minds of the purchasing public as to the source of the products in violation of 15 U.S.C. § 1114.

24. DCS has an incomplete remedy at law. The defendant's conduct has caused, and, if not enjoined, will continue to cause, irreparable harm and damage to the rights of DCS in its trademarks and service marks, business, reputation and goodwill.

25. The defendant's activities constitute willful and intentional infringements of the Mark. The defendant's knowing colorable imitation of the Mark has been, and continues to be, a violation of DCS's rights.

26. The defendant's use of the Mark has caused and is likely to cause confusion, mistake, or deception among ordinary customers of these services as to the service's origin, sponsorship, or approval of their services by DCS.

27. DCS is entitled to injunctive and monetary relief against the defendant.

28. The defendant's actions make this case exceptional under 15 U.S.C. § 1117(a).

WHEREFORE, DCS demands the following relief in its favor and against the defendant:

(a) That the defendant, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with it, be temporarily and permanently enjoined and restrained from copying, producing, marketing and selling goods or services bearing the Mark and from using any mark or logo that is confusingly similar;

(b) That the defendant be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which it has complied with the injunction;

(c) That DCS be awarded statutory damages for the defendant's willful infringement of the Mark by the defendant;

(d) That DCS's damages be trebled for the willful infringement;

(e) That DCS be awarded its costs and attorney fees;

(f) That DCS be awarded appropriate prejudgment and post-judgment interest; and

(g) That DCS be awarded such additional relief as the circumstances warrant.

**COUNT II: LANHAM ACT VIOLATION – FEDERAL UNFAIR COMPETITION,
FALSE DESCRIPTION AND FALSE DESIGNATION OF ORIGIN**

29. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

30. In or about 2010, the owner of BELLA COLLINA began using the Mark for wedding planning services and events.

31. DCS has expended considerable resources (including thousands of dollars) marketing, advertising, and promoting its services.

32. The Mark is indicia of origin of the services bearing the Mark that consumers rely upon as a symbol of assurance as to the quality of the services provided.

33. The Mark is inherently distinctive and has secondary meaning with the consuming public.

34. The Mark is distinctive and well known to the industry and members of the consuming public. The public generally associates the Mark with DCS' excellent reputation and high-quality wedding facilities services.

35. The Mark is distinctive and famous.

36. The defendant recently began and is currently using the Mark for its wedding services, which are substantially similar to DCSs' wedding services.

37. The defendant's unauthorized, intentional, and unlawful use in commerce of the Mark constitutes use in commerce of a word, term, name, symbol, or device, or a combination thereof, or a false designation of origin, false or misleading description and false representation that is likely to cause confusion, reverse confusion or mistake, or to deceive as to affiliation, connection or association of DCS with the defendant, or as to origin, sponsorship or approval of the defendant's goods, services or commercial activities by DCS, or to cause reverse confusion.

38. The defendant's acts and use of the Mark constitute unfair competition and false designation and/or false description of origin in violation of §43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

39. DCS has an incomplete remedy at law. The defendant's conduct has caused, and, if not enjoined, will continue to cause, irreparable harm and damage to the rights of DCS in its trademarks and service marks, business, reputation and goodwill.

40. The defendant's activities constitute willful and intentional violations of the Lanham Act. The defendant's knowing use of the Mark continues to be a violation of DCS's rights.

41. DCS is entitled to injunctive and monetary relief against the defendant.

42. The defendant's actions make this case exceptional under 15 U.S.C. § 1117(a).

WHEREFORE, DCS demands the following relief against the defendant:

(a) That the defendant, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with them, be temporarily and permanently enjoined and restrained from copying, producing, marketing and selling goods bearing the Mark and from using any mark or logo that is confusingly similar;

(b) That the defendant be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which they have complied with the injunction;

(c) That DCS be awarded statutory damages for the defendant's willful infringement of the Mark by the defendant;

(d) That DCS's damages be trebled for the willful infringement;

(e) That DCS be awarded its costs and attorney fees;

(f) That DCS be awarded appropriate prejudgment and post-judgment interest; and

(g) That DCS be awarded such additional relief as the circumstances warrant.

COUNT III; COMMON LAW SERVICE MARK INFRINGEMENT

43. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

44. DCS owns and enjoys common law service mark rights in the United States in and to the Mark, which are superior to any rights that the defendant may claim in any form or style with respect to the products and services provided.

45. Use of the Mark by the defendant in connection with the same or similar services as those offered by DCS is likely to cause, has caused, and will continue to cause consumer confusion as to the source of the defendant's products in that consumers and members of the trade and service will likely associate or have associated the defendant's services with or as originating from DCS to DCS's detriment.

46. WHEREFORE, DCS demands the following relief against the defendant:

(a) That the defendant, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with them, be temporarily and permanently enjoined and restrained from copying, producing, marketing and selling goods bearing the Mark and from using any mark or logo confusingly similar to those of DCS.

(b) That the defendant be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which it has complied with the injunction;

(c) That DCS be awarded damages;

(d) That DCS be awarded such additional relief as the circumstances warrant; and

(e) That DCS be awarded appropriate prejudgment and post-judgment interest.

COUNT IV: DECLARATORY JUDGMENT

47. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

48. This is an action for declaratory judgment, pursuant to 28 U.S.C. § 2201 and Federal Rule of Civil Procedure 57, to resolve an actual case and controversy between the

plaintiff and the defendant concerning the parties' respective rights to use the mark BELLA COLLINA.

49. DCS seeks a declaration from the Court that it enjoys the exclusive right to use the service mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services, and that the defendant, as the junior user, lacks the right to use the mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services.

50. There is a *bona fide*, present, practical need for the declaration given the parties' respective positions. The defendant has wrongfully attempt to register the BELLA COLLINA mark even though it knows that DCS was using the mark more than three years prior to defendant's first use of said mark.

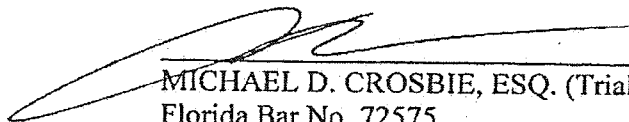
51. The declaration pertains to a present, ascertainable set of facts and controversy between the parties.

52. The defendant has a present antagonistic interest to DCS.

53. The relief sought by this count is not merely for the purposes of obtaining legal advice from the Court or answers to questions propounded out of curiosity.

WHEREFORE, DCS demands judgment in its favor, declaring: (a) as between it and the defendant, DCS enjoys the exclusive right to use the Mark; (b) that the defendant lacks the right to use, or to prohibit the use of, the Mark; and (c) such additional relief as the circumstances warrant.

Respectfully submitted,



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**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF NORTH CAROLINA**

Civil Action No. 1:15-cv-00007

BELLA COLLINA EVENTS, LLC,

Plaintiff,

v.

DCS REAL ESTATE INVESTMENTS, LLC,

Defendant.

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COMPLAINT

Plaintiff, Bella Collina Events, LLC (“BCE”), for its complaint against DCS Real Estate Investments, LLC (“DCS”) alleges the following:

1. This is a declaratory judgment action, brought pursuant to 28 U.S.C. § 2201, *et seq.*, seeking a declaratory judgment that BCE has not infringed and has not violated DCS’s alleged trademark rights to BELLA COLLINA, and, specifically, that (i) in BCE’s geographic territory, BCE’s trademark/service mark (“trademark”) rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS in BELLA COLLINA for wedding related services, and thus BCE’s use and exercise of such rights does not violate any rights of DCS; (ii) BCE’s use of BELLA COLLINA EVENTS does not constitute trademark infringement or other violation of the trademark registration DCS claims to have acquired, namely United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services; and (iii) BCE has not committed trademark

infringement in violation of 15 U.S.C. § 1114, has not committed a trademark violation, unfair competition, false designation of origin, false or misleading description or false representation in violation of 15 U.S.C. § 1125(a)(1)(A), and has not committed common law trademark infringement, against DCS. BCE further seeks a determination of whether the trademark rights in Reg. No. 2936715 for BELLA COLLINA for real estate development and construction services, to the extent they are owned by DCS, have been abandoned, rendering them void, and if so, BCE seeks the cancelation of such registration.

2. BCE is a limited liability company duly organized and existing under the laws of the State of North Carolina with its principal place of business and headquarters in Stokesdale, North Carolina.

3. DCS is, upon information and belief, a Florida limited liability company with its principal place of business in Lake County, Florida.

4. This Court has original jurisdiction in this action under 28 U.S.C. § 1331 and § 1338 and 15 U.S.C. § 1119 and § 1121(a), in that this case arises under the trademark laws of the United States. Under 28 U.S.C. § 1367, this Court has supplemental jurisdiction over any related claims arising under state law. This Court has the power to issue the declaration(s) sought pursuant to 28 U.S.C. § 2201, *et seq.*

5. Venue is proper in this District under 28 U.S.C. § 1391(b) and also under 28 U.S.C. § 1391(c) in that a substantial part of the events giving rise to this claim occurred within this District—namely, BCE’s use of BELLA COLLINA EVENTS as a

trademark in connection with its wedding-related services. Furthermore, DCS conducts business in and otherwise has sufficient contacts with this District so as to subject it to personal jurisdiction. Among other activities, DCS operates a website through which bookings for certain of its services may be made online from this District.

BCE's Rights in its mark BELLA COLLINA EVENTS

6. Since at least mid-February 2013, BCE has been using BELLA COLLINA EVENTS as a trademark in connection with its wedding related services, including its planning and arranging of wedding ceremonies, providing facilities for wedding ceremonies, and wedding ceremony planning and related consulting services.

7. BCE operates and provides its wedding services in, around and from its scenic location at 9500 Mt. Carmel Road, Stokesdale, North Carolina 27357.

8. Wedding services of the type provided by BCE, although qualifying as interstate commerce subject to Congressional regulation, are local or regional in nature. Persons needing wedding services typically first select the geographic location for the wedding and then, with that city or region in mind, seek a wedding venue and wedding service providers, such as BCE.

9. Due to, *inter alia*, BCE's use of its mark, its North Carolina-directed marketing, and the high quality services rendered, BCE's services and its trademark have become well known locally and regionally in its geographic territory in and around Stokesdale, North Carolina.

10. As a consequence of BCE's use of BELLA COLLINA EVENTS in connection with its services, BCE has developed common law trademark rights in the term in geographic regions in and around Stokesdale, North Carolina, including without limitation the Triad region of North Carolina.

11. At the time BCE adopted its mark, BELLA COLLINA EVENTS, BCE understood that no one was using that mark, or any variants thereof, in connection with wedding services in or around North Carolina, and BCE did not know of any uses of that mark, or any variants, anywhere for any products or services.

The Failed Florida Real Estate Development

12. Subsequent to its adoption of its mark, BELLA COLLINA EVENTS, BCE learned that on April 25, 2003, a Georgia limited liability company named Ginn-LA Pine Island, Ltd., LLLP, having a Celebration, Florida address, filed a federal, intent-to-use trademark application for BELLA COLLINA in connection with "real estate development and construction services, namely planning, developing, and operating an upscale residential golf community and resort." As reflected by that trademark application file, the real estate development services allegedly being under the name BELLA COLLINA related strictly to a single location and real estate development of a single proposed golf community of that name in Montverde, Florida in Lake County, Florida. The community was to be named BELLA COLLINA. All services provided by

Ginn-LA Pine Island, Ltd., LLLP under that name concerned that single real estate development planned for Montverde, Florida in Lake County, Florida.

13. Upon information and belief, wedding services were not intended to be provided and were not provided at the BELLA COLLINA real estate development.

14. Upon information and belief, that Montverde, Florida real estate development project failed when the 2007/2008 housing bubble burst and the recession hit. Upon information and belief, home site owners abandoned sites they had reserved and ceased paying dues to the development's property associations and/or club.

15. Upon information and belief, any real estate development and construction services previously rendered under the BELLA COLLINA mark in connection with the BELLA COLLINA real estate development largely, if not completely, ceased.

16. Years later, in a document dated April 11, 2014, DCS purported to acquire through assignment United States trademark registration No. 2936715 and to have the assignment back-dated or retroactively applicable, *nunc pro tunc*, to June 27, 2012.

17. DCS's purported assignment was an assignment in gross.

18. DCS's purported assignment was invalid.

19. Upon information and belief, Ginn-LA Pine Island, Ltd., LLLP discontinued the use of BELLA COLLINA in connection with the services identified in United States trademark registration No. 2936715 with the intent not to resume such use.

20. Upon information and belief, trademark rights for BELLA COLLINA for real estate development and construction services, including rights in United States trademark registration No. 2936715, have been abandoned.

The United States Patent and Trademark Office Found No Conflict between BCE's BELLA COLLINA EVENTS and the Registration for real estate and development services

21. On August 11, 2014, BCE filed a United States trademark application (Application No. 86362378) for BELLA COLLINA EVENTS for its wedding services of planning and arranging of wedding ceremonies, providing facilities for wedding ceremonies, and wedding ceremony planning and arranging consultation services.

22. The United States Patent and Trademark Office's examining attorney, who was charged with reviewing whether any prior United States trademark registration or application presented a conflict sufficient to bar BCE's application, found no such conflicting marks, and implicitly found no conflict between BCE's application and United States trademark registration No. 2936715.

23. The United States Patent and Trademark Office examiner wrote in an office action dated November 25, 2014 with respect to BCE's trademark application for BELLA COLLINA EVENTS: "The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d)."

DCS's Claims

24. DCS claims that BELLA COLLINA has been used in connection with wedding services provided at and around its location at 15920 County Road 455, Montverde, Florida in Lake County, Florida.

25. Upon information and belief, DCS's alleged BELLA COLLINA wedding services were not provided in BCE's geographic territory until after BCE had established its own trademark rights in such territory.

26. Despite its lack of trademark rights in an overlapping geographic territory and its lack of priority of trademark rights, DCS claims that BCE has infringed or otherwise violated DCS's alleged trademark rights.

27. DCS's claims lack merit.

28. There is a *bona fide*, present, practical need for the declarations sought given the parties' respective positions. There is a present, ascertainable set of facts and controversy between the parties, and DCS has a present interest antagonistic to BCE.

29. Although BCE has not purposefully availed itself of the laws of the State of Florida and although the court in Florida cannot properly exercise personal jurisdiction over BCE, DCS has filed a lawsuit against BCE for alleged trademark infringement and related claims in the United States District Court for the Middle District of Florida, Case No. 5:14-cv-678. BCE anticipates filing a motion to dismiss that case for lack of personal jurisdiction.

30. DCS's claims are unjustified, unreasonable and not required by law.

31. DCS's allegations present a real, imminent, and justiciable dispute, and cause substantial injury to BCE in that they put into jeopardy and place a cloud upon whether BCE may utilize the BELLA COLLINA EVENTS mark.

32. Were BCE to capitulate to the demands of DCS, BCE would be substantially damaged, both monetarily and in terms of lost consumer recognition and goodwill.

FIRST CLAIM FOR RELIEF
[Declaratory Judgment]

33. The allegations of all preceding paragraphs (1-32) are incorporated by reference as if fully set forth herein.

34. BCE is entitled to a declaration by the Court that:

a. BCE has not infringed and has not violated DCS's alleged trademark rights to BELLA COLLINA;

b. In BCE's geographic territory, BCE's trademark rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS in BELLA COLLINA for wedding related services;

c. BCE's use and exercise of its trademark rights does not violate any rights of DCS;

d. BCE's use of BELLA COLLINA EVENTS, and any other marks it may use, does not constitute trademark infringement or other violation of the trademark registration DCS claims to have acquired, namely United States

trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services;

e. BCE has not committed against DCS trademark infringement in violation of 15 U.S.C. § 1114;

f. BCE has not committed against DCS a trademark violation, unfair competition, false designation of origin, false or misleading description or false representation in violation of 15 U.S.C. § 1125(a)(1)(A);

g. BCE has not committed against DCS common law trademark infringement; and

h. The purported assignment to DCS of United States trademark registration No. 2936715 was invalid and no trademark rights associated with United States trademark registration No. 2936715 were transferred to DCS.

SECOND CLAIM FOR RELIEF
[Cancellation]

35. The allegations of all preceding paragraphs (1-34) are incorporated by reference as if fully set forth herein.

36. The trademark rights to United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services have been abandoned, through either the discontinuance of use of the mark with such services with an intent not to resume such use, nonuse for three consecutive years, or both.

37. DCS owns no valid trademark rights to United States trademark registration No. 2936715, as the purported assignment was invalid and, to the extent the trademark

had been abandoned by the time of the assignment, there were no then-existing transferrable rights in the registration.

38. To the extent the Court determines that DCS is the owner of United States trademark registration No. 2936715, the Court should exercise its power under 15 U.S.C. § 1119 to cancel United States trademark registration No. 2936715 due to abandonment of the rights.

JURY DEMAND

39. BCE demands a jury trial on all issues triable by a jury.

WHEREFORE, BCE prays that this Court:

1. Declare that:

a. BCE has not infringed and has not violated DCS's alleged trademark rights to BELLA COLLINA;

b. In BCE's geographic territory, BCE's trademark mark rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS in BELLA COLLINA for wedding related services;

c. BCE's use and exercise of its trademark rights does not violate any rights of DCS;

d. BCE's use of BELLA COLLINA EVENTS, and any other marks it may use, does not constitute trademark infringement or other violation of the

trademark registration DCS claims to have acquired, namely United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services;

e. BCE has not committed against DCS trademark infringement in violation of 15 U.S.C. § 1114;

f. BCE has not committed against DCS a trademark violation, unfair competition, false designation of origin, false or misleading description or false representation in violation of 15 U.S.C. § 1125(a)(1)(A);

g. BCE has not committed against DCS common law trademark infringement; and

h. The purported assignment to DCS of United States trademark registration No. 2936715 was invalid and no trademark rights associated with United States trademark registration No. 2936715 were transferred to DCS.

2. If the Court determines that DCS is the owner of United States trademark registration No. 2936715, order the cancellation of United States trademark registration No. 2936715;

3. Tax the costs and expenses of this action to DCS;

4. Award to BCE from DCS such reasonable attorneys' fees as may be allowed by 15 U.S.C. § 1117 if this case is found to be exceptional, or by other laws; and

5. Award such other and further relief as the Court finds just and proper.

6. BCE demands a jury trial on all issues triable by a jury.

Respectfully submitted, this the 7th day of January, 2015

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Attorneys for Bella Collina Events, LLC

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF NORTH CAROLINA**

BELLA COLLINA EVENTS, LLC,

Plaintiff,

CASE NO. 1:15-cv-00007

v.

DCS REAL ESTATE INVESTMENTS, LLC,

Defendant.

**DCS REAL ESTATE INVESTMENTS, LLC'S ANSWER TO COMPLAINT,
AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS**

The defendant, DCS Real Estate Investments, LLC ("DCS"), through the undersigned counsel, answers the allegations in the plaintiff, Bella Collina Events, LLC's, Complaint in the correspondingly-numbered paragraphs below.

1. This is a declaratory judgment action, brought pursuant to 28 U.S.C. § 2201, *et seq.*, seeking a declaratory judgment that BCE has not infringed and has not violated DCS's alleged trademark rights to BELLA COLLINA, and, specifically, that (i) in BCE's geographic territory, BCE's trademark/service mark ("trademark") rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS in BELLA COLLINA for wedding related services, and thus BCE's use and exercise of such rights does not violate any rights of DCS; (ii) BCE's use of BELLA COLLINA EVENTS does not constitute trademark infringement or other violation of the trademark registration DCS claims to have acquired, namely United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services; and (iii) BCE has not committed trademark infringement in violation of 15 U.S.C. § 1114, has not committed a trademark violation, unfair competition, false designation of origin, false or misleading description or false representation in

violation of 15 U.S.C. § 1125(a)(1)(A), and has not committed common law trademark infringement, against DCS. BCE further seeks a determination of whether the trademark rights in Reg. No. 2936715 for BELLA COLLINA for real estate development and construction services, to the extent they are owned by DCS, have been abandoned, rendering them void, and if so, BCE seeks the cancelation of such registration.

ANSWER: DCS admits the allegation for the purposes of subject matter jurisdiction, but denies that BCE is entitled to the declaratory relief or cancellation sought.

2. BCE is a limited liability company duly organized and existing under the laws of the State of North Carolina with its principal place of business and headquarters in Stokesdale, North Carolina.

ANSWER: Admitted.

3. DCS is, upon information and belief, a Florida limited liability company with its principal place of business in Lake County, Florida.

ANSWER: Admitted.

4. This Court has original jurisdiction in this action under 28 U.S.C. § 1331 and § 1338 and 15 U.S.C. § 1119 and § 1121(a), in that this case arises under the trademark laws of the United States. Under 28 U.S.C. § 1367, this Court has supplemental jurisdiction over any related claims arising under state law. This Court has the power to issue the declaration(s) sought pursuant to 28 U.S.C. § 2201, *et seq.*

ANSWER: Admitted.

5. Venue is proper in this District under 28 U.S.C. § 1391(b) and also under 28 U.S.C. § 1391(c) in that a substantial part of the events giving rise to this claim occurred within this District—namely, BCE’s use of BELLA COLLINA EVENTS as a trademark in connection with its wedding-related services. Furthermore, DCS conducts business in and otherwise has

sufficient contacts with this District so as to subject it to personal jurisdiction. Among other activities, DCS operates a website through which bookings for certain of its services may be made online from this District.

ANSWER: DCS denies that venue is proper or that personal jurisdiction exists over DCS.

6. Since at least mid-February 2013, BCE has been using BELLA COLLINA EVENTS as a trademark in connection with its wedding related services, including its planning and arranging of wedding ceremonies, providing facilities for wedding ceremonies, and wedding ceremony planning and related consulting services.

ANSWER: DCS admits that BCE has used BELLA COLLINA since no earlier than February 2013 in connection with advertising and providing wedding services.

Otherwise, DCS lacks knowledge with regard to this allegation and, accordingly, denies it.

7. BCE operates and provides its wedding services in, around and from its scenic location at 9500 Mt. Carmel Road, Stokesdale, North Carolina 27357.

ANSWER: DCS lacks knowledge with regard to this allegation and, accordingly, denies it.

8. Wedding services of the type provided by BCE, although qualifying as interstate commerce subject to Congressional regulation, are local or regional in nature. Persons needing wedding services typically first select the geographic location for the wedding and then, with that city or region in mind, seek a wedding venue and wedding service providers, such as BCE.

ANSWER: Denied.

9. Due to, *inter alia*, BCE's use of its mark, its North Carolina-directed marketing, and the high quality services rendered, BCE's services and its trademark have become well known locally and regionally in its geographic territory in and around Stokesdale, North Carolina.

ANSWER: Denied.

10. As a consequence of BCE's use of BELLA COLLINA EVENTS in connection with its services, BCE has developed common law trademark rights in the term in geographic regions in and around Stokesdale, North Carolina, including without limitation the Triad region of North Carolina.

ANSWER: Denied.

11. At the time BCE adopted its mark, BELLA COLLINA EVENTS, BCE understood that no one was using that mark, or any variants thereof, in connection with wedding services in or around North Carolina, and BCE did not know of any uses of that mark, or any variants, anywhere for any products or services.

ANSWER: DCS lacks knowledge with regard to this allegation and, accordingly, denies it.

12. Subsequent to its adoption of its mark, BELLA COLLINA EVENTS, BCE learned that on April 25, 2003, a Georgia limited liability company named Ginn-LA Pine Island, Ltd., LLLP, having a Celebration, Florida address, filed a federal, intent-to-use trademark application for BELLA COLLINA in connection with "real estate development and construction services, namely planning, developing, and operating an upscale residential golf community and resort." As reflected by that trademark application file, the real estate development services allegedly being under the name BELLA COLLINA related strictly to a single location and real estate development of a single proposed golf community of that name in Montverde, Florida in

Lake County, Florida. The community was to be named BELLA COLLINA. All services provided by Ginn-LA Pine Island, Ltd., LLLP under that name concerned that single real estate development planned for Montverde, Florida in Lake County, Florida.

ANSWER: DCS admits that Ginn-LA Pine Island (“Ginn”) applied for the BELLA COLLINA mark in 2003, that the application speaks for itself, and that Ginn’s real estate development, club, golf course, spa, and related events were marketed using the BELLA COLLINA mark. Otherwise, DCS denies the allegation.

13. Upon information and belief, wedding services were not intended to be provided and were not provided at the BELLA COLLINA real estate development.

ANSWER: Denied.

14. Upon information and belief, that Montverde, Florida real estate development project failed when the 2007/2008 housing bubble burst and the recession hit. Upon information and belief, home site owners abandoned sites they had reserved and ceased paying dues to the development’s property associations and/or club.

ANSWER: DCS admits that some owners in the Bella Collina development ceased paying dues and assessments at various times between 2004 and the present. Otherwise, the allegation is denied.

15. Upon information and belief, any real estate development and construction services previously rendered under the BELLA COLLINA mark in connection with the BELLA COLLINA real estate development largely, if not completely, ceased.

ANSWER: Denied.

16. Years later, in a document dated April 11, 2014, DCS purported to acquire through assignment United States trademark registration No. 2936715 and to have the assignment back-dated or retroactively applicable, *nunc pro tunc*, to June 27, 2012.

ANSWER: Admitted that DCS acquired all of the assets relating to the Bella Collina development, including the BELLA COLLINA mark, in June 2012, and that the USPTO was notified of the assignment on or around April 11, 2014. Otherwise the allegation is denied.

17. DCS's purported assignment was an assignment in gross.

ANSWER: Denied.

18. DCS's purported assignment was invalid.

ANSWER: Denied.

19. Upon information and belief, Ginn-LA Pine Island, Ltd., LLLP discontinued the use of BELLA COLLINA in connection with the services identified in United States trademark registration No. 2936715 with the intent not to resume such use.

ANSWER: Denied.

20. Upon information and belief, trademark rights for BELLA COLLINA for real estate development and construction services, including rights in United States trademark registration No. 2936715, have been abandoned.

ANSWER: Denied.

21. On August 11, 2014, BCE filed a United States trademark application (Application No. 86362378) for BELLA COLLINA EVENTS for its wedding services of planning and arranging of wedding ceremonies, providing facilities for wedding ceremonies, and wedding ceremony planning and arranging consultation services.

ANSWER: Admitted that after DCS alerted BCE of its infringement, BCE filed the above-described application.

22. The United States Patent and Trademark Office's examining attorney, who was charged with reviewing whether any prior United States trademark registration or application

presented a conflict sufficient to bar BCE's application, found no such conflicting marks, and implicitly found no conflict between BCE's application and United States trademark registration No. 2936715.

ANSWER: DCS lacks knowledge with respect to this allegation and, accordingly, denies it.

23. The United States Patent and Trademark Office examiner wrote in an office action dated November 25, 2014 with respect to BCE's trademark application for BELLA COLLINA EVENTS: "The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d)."

ANSWER: DCS lacks knowledge with respect to this allegation and, accordingly, denies it.

24. DCS claims that BELLA COLLINA has been used in connection with wedding services provided at and around its location at 15920 County Road 455, Montverde, Florida in Lake County, Florida.

ANSWER: Admitted.

25. Upon information and belief, DCS's alleged BELLA COLLINA wedding services were not provided in BCE's geographic territory until after BCE had established its own trademark rights in such territory.

ANSWER: Denied.

26. Despite its lack of trademark rights in an overlapping geographic territory and its lack of priority of trademark rights, DCS claims that BCE has infringed or otherwise violated DCS's alleged trademark rights.

ANSWER: DCS admits that BCE has infringed its BELLA COLLINA mark and

otherwise violated DCS's rights in the mark. Otherwise, the allegation is denied.

27. DCS's claims lack merit.

ANSWER: Denied.

28. There is a *bona fide*, present, practical need for the declarations sought given the parties' respective positions. There is a present, ascertainable set of facts and controversy between the parties, and DCS has a present interest antagonistic to BCE.

ANSWER: DCS admits that its interests are antagonistic to those of BCE.

Otherwise, DCS denies the allegation.

29. Although BCE has not purposefully availed itself of the laws of the State of Florida and although the court in Florida cannot properly exercise personal jurisdiction over BCE, DCS has filed a lawsuit against BCE for alleged trademark infringement and related claims in the United States District Court for the Middle District of Florida, Case No. 5:14-cv-678. BCE anticipates filing a motion to dismiss that case for lack of personal jurisdiction.

ANSWER: DCS admits that it filed a lawsuit against BCE for trademark infringement and related claims in the United States District Court for the Middle District of Florida and that BCE filed a motion to dismiss or transfer. Otherwise, DCS denies the allegation.

30. DCS's claims are unjustified, unreasonable and not required by law.

ANSWER: Denied.

31. DCS's allegations present a real, imminent, and justiciable dispute, and cause substantial injury to BCE in that they put into jeopardy and place a cloud upon whether BCE may utilize the BELLA COLLINA EVENTS mark.

ANSWER: Denied.

32. Were BCE to capitulate to the demands of DCS, BCE would be substantially damaged, both monetarily and in terms of lost consumer recognition and goodwill.

ANSWER: Denied.

**FIRST CLAIM FOR RELIEF
[Declaratory Judgment]**

33. The allegations of all preceding paragraphs (1-32) are incorporated by reference as if fully set forth herein.

ANSWER: DCS reasserts its responses to paragraphs 1 through 32.

34. BCE is entitled to a declaration by the Court that:

a. BCE has not infringed and has not violated DCS's alleged trademark rights to BELLA COLLINA;

b. In BCE's geographic territory, BCE's trademark rights in BELLA COLLINA EVENTS for wedding related services have priority over trademark rights claimed by DCS in BELLA COLLINA for wedding related services;

c. BCE's use and exercise of its trademark rights does not violate any rights of DCS;

d. BCE's use of BELLA COLLINA EVENTS, and any other marks it may use, does not constitute trademark infringement or other violation of the trademark registration DCS claims to have acquired, namely United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services;

e. BCE has not committed against DCS trademark infringement in violation of 15 U.S.C. § 1114;

f. BCE has not committed against DCS a trademark violation, unfair competition, false designation of origin, false or misleading description or false representation in violation of 15 U.S.C. § 1125(a)(1)(A);

g. BCE has not committed against DCS common law trademark infringement; and

h. The purported assignment to DCS of United States trademark registration No. 2936715 was invalid and no trademark rights associated with United States trademark registration No. 2936715 were transferred to DCS.

ANSWER: Denied.

SECOND CLAIM FOR RELIEF [Cancellation]

35. The allegations of all preceding paragraphs (1-34) are incorporated by reference as if fully set forth herein.

ANSWER: DCS reasserts its responses to paragraphs 1 - 34.

36. The trademark rights to United States trademark registration No. 2936715 for BELLA COLLINA for real estate development and construction services have been abandoned, through either the discontinuance of use of the mark with such services with an intent not to resume such use, nonuse for three consecutive years, or both.

ANSWER: Denied.

37. DCS owns no valid trademark rights to United States trademark registration No. 2936715, as the purported assignment was invalid and, to the extent the trademark had been abandoned by the time of the assignment, there were no then-existing transferrable rights in the registration.

ANSWER: Denied.

38. To the extent the Court determines that DCS is the owner of United States trademark registration No. 2936715, the Court should exercise its power under 15 U.S.C. § 1119 to cancel United States trademark registration No. 2936715 due to abandonment of the rights.

ANSWER: Denied.

JURY DEMAND

39. BCE demands a jury trial on all issues triable by a jury.

ANSWER: To the extent this is an allegation for which a response is required, DCS admits that BCE has demanded a jury trial.

AFFIRMATIVE DEFENSES

- A. The Complaint fails to state a claim for which relief can be granted.
- B. The claims are barred by the plaintiff's unclean hands. The plaintiff has intentionally and willfully infringed DCS's famous BELLA COLLINA mark, and has committed fraud on the United States Patent and Trademark Office.
- C. The claims are barred by estoppel.
- D. The claims are barred because the plaintiff is not the owner of a registered mark, or a distinctive mark, and thus the plaintiff lacks standing.
- E. The claims are barred by the plaintiff's prior use of a counterfeit of DCS's mark.
- F. The claims are barred to the extent the term sought to be protected is generic or descriptive without secondary meaning.
- G. The claims are barred because the Court lacks personal jurisdiction over DCS.

WHEREFORE, DCS respectfully demands that the Court enter judgment in its favor and against the plaintiff on the plaintiff's claims, deem this case extraordinary and award DCS the attorney fees it incurred, and award such additional relief as the circumstances warrant.

COUNTERCLAIMS

Pursuant to Federal Rule of Civil Procedure 13, DCS Real Estate Investments, LLC ("DCS"), hereby asserts counterclaims against Bella Collina Events, LLC as follows:

Jurisdiction, Parties & Venue

1. This Court has subject matter jurisdiction pursuant to 15 U.S.C. §§ 1125(a) (Lanham Act), 28 U.S.C. § 1331 (federal question) and 1338 (patent, trademark and copyright), and pursuant to 28 U.S.C. § 1367 (supplemental jurisdiction).

2. The counterclaimant, DCS, is a Florida Limited Liability Company with its principal place of business in Lake County, Florida.

3. The counter-defendant, Bella Collina Events, LLC ("BCE") is a North Carolina limited liability company with its principal place of business in Guilford County, North Carolina.

4. Jurisdiction over the counter-defendant exists because it has its principal place of business in the State of North Carolina. It conducts business inside and outside of North Carolina through, among other media, The Wedding Wire and www.theknot.com, and has caused economic harm to DCS.

5. Venue is proper in this district pursuant to 28 U.S.C. § 1400(a) and 28 U.S.C. § 1391(b), because the defendant resides and conducts business in this judicial district.

6. DCS has retained the undersigned firm and has agreed to pay a reasonable attorney fee.

7. All conditions precedent to this action have occurred or have been waived. DCS demands a jury trial on all issues so triable.

General Allegations

8. In 2012, DCS acquired the club house, golf course, and other assets located at and part of the exclusive Lake County, Florida residential community known as “Bella Collina.” One of the assets acquired by DCS was the service mark BELLA COLLINA (the “Mark”).

9. BELLA COLLINA is a registered service mark on the United States Patent and Trademark Office’s Principal Register. Its Registration Number is 2936715. The service mark is also incontestable. Additionally, DCS owns the common law trademark rights to BELLA COLLINA for a variety of goods and services, including, *inter alia*, weddings, wedding planning, and other events.

10. DCS and its predecessor have used BELLA COLLINA to market and promote the Bella Collina community and facilities, including weddings, wedding planning, and other events.

11. Since 2003, the owners of BELLA COLLINA have maintained continuous and uninterrupted use of the service mark through advertising, promotions and websites. Since 2010, DCS and its predecessor have promoted the Bella Collina facilities as a destination wedding venue to consumers, and potential consumers, around the country and world.

12. BCE owns a website found at URL <http://www.bellacollinamansion.com>. Through the website, BCE promotes wedding services, planning, and events. BCE also advertises nationally, at wedding-oriented sites such as The Wedding Wire and www.theknot.com, its wedding services.

13. As a result of BCE’s advertisements and solicitations, potential customers have actually confused BCE’s services with those offered by DCS.

14. DCS contacted BCE to inform BCE that DCS owned and used BELLA COLLINA in the advertising, promotion, and sale of wedding services, including planning and events.

15. Rather than acting to prevent confusion or changing the name under which it recently began conducting business, BCE responded by attempting to register with the United States Patent and Trademark Office the mark BELLA COLLINA EVENTS for wedding planning and services under application serial number 86362378. Such attempt at registration is fraudulent and improper as BCE was well aware that it is not the prior user of the BELLA COLLINA mark for wedding planning and events.

COUNT I: LANHAM ACT VIOLATION – SERVICE MARK INFRINGEMENT

16. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

17. By no later than 2010, the owner of BELLA COLLINA began offering wedding facilities and services using the BELLA COLLINA Mark. This use included using the BELLA COLLINA Mark in advertisements and other media, including www.theknot.com. BELLA COLLINA was used in national advertising campaigns to promote the wedding facilities and services.

18. DCS expended considerable resources (including hundreds of thousands of dollars) marketing, advertising, and promoting wedding services under the Mark throughout the United States and the State of Florida.

19. The BELLA COLLINA Mark is strong, distinctive, and well known to the general public. The public generally associates the Mark with DCS's events, including wedding planning and events. DCS's facilities have become famous nationally for high-end destination weddings.

20. The Mark has never been abandoned.

21. The Mark is distinctive and famous.

22. BCE has been and currently is using the Mark to advertise, promote, and sell wedding planning and event services. BCE has gone so far as to attempt to register a

confusingly similar mark even though plaintiff admits that it first began using the confusingly similar and/or counterfeit mark in 2013, more than three years after DCS's first use of the Mark.

23. BCE's unauthorized reproduction, copying, imitation, and use of the Mark constitutes service mark infringement and is likely to cause confusion and mistake in the minds of the purchasing public as to the source of the products in violation of 15 U.S.C. § 1114.

24. DCS has an incomplete remedy at law. BCE's conduct has caused, and, if not enjoined, will continue to cause, irreparable harm and damage to the rights of DCS in its trademarks and service marks, business, reputation and goodwill.

25. BCE's activities constitute willful and intentional infringements of the Mark. BCE's knowing colorable imitation of the Mark has been, and continues to be, a violation of DCS's rights.

26. BCE's use of the Mark has caused and is likely to cause confusion, mistake, or deception among ordinary customers of these services as to the service's origin, sponsorship, or approval of their services by DCS.

27. DCS is entitled to injunctive and monetary relief against BCE.

28. BCE's actions make this case exceptional under 15 U.S.C. § 1117(a).

WHEREFORE, DCS demands the following relief in its favor and against BCE:

(a) That BCE, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with it, be temporarily and permanently enjoined and restrained from copying, producing, marketing and selling goods or services bearing the Mark and from using any mark or logo that is confusingly similar;

(b) That BCE be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which it has complied with the injunction;

(c) That DCS be awarded damages for BCE's willful infringement of the Mark by BCE;

(d) That DCS's damages be trebled for the willful infringement;

(e) That DCS be awarded its costs and attorney fees;

(f) That DCS be awarded appropriate prejudgment and post-judgment interest; and

(g) That DCS be awarded such additional relief as the circumstances warrant.

**COUNT II: LANHAM ACT VIOLATION – FEDERAL UNFAIR COMPETITION,
FALSE DESCRIPTION AND FALSE DESIGNATION OF ORIGIN**

29. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

30. In or about 2010, the owner of BELLA COLLINA began using the Mark for wedding planning services and events.

31. DCS has expended considerable resources (including hundreds of thousands of dollars) marketing, advertising, and promoting its services and BELLA COLLINA.

32. The Mark is indicia of origin of the services bearing the Mark that consumers rely upon as a symbol of assurance as to the quality of the services provided.

33. The Mark is inherently distinctive and has secondary meaning with the consuming public.

34. The Mark is distinctive and well known to the industry and members of the consuming public. The public generally associates the Mark with DCS's excellent reputation and high-quality wedding facilities services.

35. The Mark is distinctive and famous.

36. BCE recently began and is currently using the Mark for its wedding services, which are substantially similar to DCS's wedding services.

37. BCE's unauthorized, intentional, and unlawful use in commerce of the Mark constitutes use in commerce of a word, term, name, symbol, or device, or a combination thereof, or a false designation of origin, false or misleading description and false representation that is likely to cause confusion, reverse confusion or mistake, or to deceive as to affiliation, connection or association of DCS with BCE, or as to origin, sponsorship or approval of BC's goods, services or commercial activities by DCS, or to cause reverse confusion.

38. BCE's acts and use of the Mark constitute unfair competition and false designation and/or false description of origin in violation of §43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

39. DCS has an incomplete remedy at law. BCE's conduct has caused, and, if not enjoined, will continue to cause, irreparable harm and damage to the rights of DCS in its trademarks and service marks, business, reputation and goodwill.

40. BCE's activities constitute willful and intentional violations of the Lanham Act. BCE's knowing use of the Mark continues to be a violation of DCS's rights.

41. DCS is entitled to injunctive and monetary relief against BCE.

42. BCE's actions make this case exceptional under 15 U.S.C. § 1117(a).

WHEREFORE, DCS demands the following relief against BCE:

(a) That BCE, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with them, be temporarily and permanently

enjoined and restrained from copying, producing, marketing and selling goods bearing the Mark, and from using any mark or logo that is confusingly similar;

(b) That BCE be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which they have complied with the injunction;

(c) That DCS be awarded damages for BCE's willful infringement of the Mark by BCE;

(d) That DCS's damages be trebled for the willful infringement;

(e) That DCS be awarded its costs and attorney fees;

(f) That DCS be awarded appropriate prejudgment and post-judgment interest; and

(g) That DCS be awarded such additional relief as the circumstances warrant.

COUNT III: COMMON LAW SERVICE MARK INFRINGEMENT

43. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

44. DCS owns and enjoys common law service mark rights in the United States in and to the Mark, which are superior to any rights that BCE may claim in any form or style with respect to the products and services provided.

45. Use of the Mark by BCE in connection with the same or similar services as those offered by DCS is likely to cause, has caused, and will continue to cause consumer confusion as to the source of BCE's products in that consumers and members of the trade and service will likely associate or have associated BCE's services with or as originating from DCS to DCS's detriment.

46. WHEREFORE, DCS demands the following relief against BCE:

(a) That BCE, including its agents, employees, successors, assigns, and all other persons acting in concert with or affiliated with them, be temporarily and permanently enjoined and restrained from copying, producing, marketing and selling goods bearing the Mark, and from using any mark or logo confusingly similar to those of DCS.

(b) That BCE be ordered to file, within thirty (30) days of the issuance of the injunction, a sworn report setting forth in detail the manner in which it has complied with the injunction;

(c) That DCS be awarded damages;

(d) That DCS be awarded such additional relief as the circumstances warrant;
and

(e) That DCS be awarded appropriate prejudgment and post-judgment interest.

COUNT IV: DECLARATORY JUDGMENT

47. DCS incorporates herein by reference the allegations in Paragraphs 1 through 15.

48. This is an action for declaratory judgment, pursuant to 28 U.S.C. § 2201 and Federal Rule of Civil Procedure 57, to resolve an actual case and controversy between BCE and the defendant concerning the parties' respective rights to use the mark BELLA COLLINA.

49. DCS seeks a declaration from the Court that it enjoys the exclusive right to use the service mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services, and that BCE, as the junior user, lacks the right to use the mark BELLA COLLINA in connection with the marketing and sale of wedding planning, services, events, and related products and services.

50. There is a *bona fide*, present, practical need for the declaration given the parties' respective positions. BCE has wrongfully attempted to register the BELLA COLLINA mark even though it knows that DCS was using the mark more than three years prior to plaintiff's first use of said mark.

51. The declaration pertains to a present, ascertainable set of facts and controversy between the parties.

52. BCE has a present antagonistic interest to DCS.

53. The relief sought by this count is not merely for the purposes of obtaining legal advice from the Court or answers to questions propounded out of curiosity.

WHEREFORE, DCS demands judgment in its favor, declaring: (a) as between it and the defendant, DCS enjoys the exclusive right to use the Mark; (b) that BCE lacks the right to use, or to prohibit the use of, the Mark; and (c) such additional relief as the circumstances warrant.

April 17, 2015

s/Christopher M. Kelly

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ATTORNEYS FOR DEFENDANT

CERTIFICATE OF SERVICE

I certify that on April 17, 2015, I electronically filed the foregoing with the Clerk of the Court which will send a notice of electronic filing to all counsel of record.

s/Christopher M. Kelly
Christopher M. Kelly